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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/586,131	06/02/2000	Marc Delcourt	1184-00	6329

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EXAMINER

FRIEND, TOMAS H F

ART UNIT PAPER NUMBER

1639

DATE MAILED: 01/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No. 09/586,131	Applicant(s) DELCOURT, MARC	
Examiner Tomas Friend	Art Unit 1639	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 25 November 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) The period for reply expires _____ months from the mailing date of the final rejection.
- b) The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

- 1. A Notice of Appeal was filed on 25 November 2002. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
- 2. The proposed amendment(s) will not be entered because:
 - (a) they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) they raise the issue of new matter (see Note below);
 - (c) they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

- 3. Applicant's reply has overcome the following rejection(s): _____.
- 4. Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
- 5. The a) affidavit, b) exhibit, or c) request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
- 6. The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
- 7. For purposes of Appeal, the proposed amendment(s) a) will not be entered or b) will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

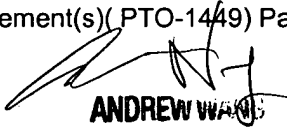
Claim(s) allowed: None.

Claim(s) objected to: None.

Claim(s) rejected: 1-19.

Claim(s) withdrawn from consideration: 20-22.

- 8. The proposed drawing correction filed on _____ is a) approved or b) disapproved by the Examiner.
- 9. Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
- 10. Other: _____


ANDREW WANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

Tomas Friend, Ph.D.
26 December 2002

Continuation of 2. NOTE: The proposed amendment would lead to the reinstatement of a withdrawn rejection. The proposed amendment removes the limitation regarding the method being useful to isolate a nucleic acid fragment and diagnose a genetic disease, which would lead to the reinstatement of the rejection under 35 U.S.C. 101 previously withdrawn.

The claimed invention is a method of isolating an intact clone of one target nucleic acid fragment having a known characteristic.

Applicant argues that the method can be used to isolate a nucleic acid sequence with known utility. Applicant's argument has been fully considered but it is not persuasive. Identifying a nucleic acid fragment that is already known or indentifying a sequence with an unspecified enzymatic activity is not a specific and substantial utility. Applicants do not exemplify or assert a specific and substantial utility in the application as filed.

Applicant argues that the specific and substantial utility is to isolate a target nucleic acid sequence from a mixture of DNA fragments of similar size. Applicant's argument has been fully considered but it is not persuasive. The specific and substantial utility to isolate a target nucleic acid sequence from a mixture of DNA fragments of similar size not asserted in the application as filed. Further, the claimed method isolates fragments based upon a known characteristic with no limitation regarding similar sizes of fragments.